

REMARKS

Applicant has carefully considered the Office Action issued October 30, 2007 by the Examiner and in view of the arguments presented by the Examiner, the claims have now been amended to distinguish the present invention over the prior art cited by the Examiner.

In particular, the Examiner has rejected the claims based upon Feustle, U.S. Patent 5,565,892. As now amended, Applicant believes that Claims 1 and 3 are distinguishable from Feustle in that they specifically require that the thickness of the lines increase with increasing distance from the source of illumination.

In addition, the Examiner also argues that while Feustle does not specifically articulate that spacings between the lines and/or thickness of the lines are chosen to obtain a desired intensity of illumination at selected areas of the sheet, the Examiner contends that this is an intrinsic property of the display of Feustle. There is no suggestion in Feustle that there should be any variations in the thicknesses of the lines.

However, by employing hindsight reconstruction, the Examiner has selected specific prior art elements and combined these elements in a manner which is not taught in the references, and has used this improper combination in rejecting the present invention.

Furthermore, the law is well settled that a prima facie case of obviousness must be based upon an objective assessment of the prior art and cannot merely represent a

hindsight reconstruction of the Applicants' invention. In addition, the motivation for combining the prior art references in the manner proposed by the Examiner must be found in the prior art.

These well-established principals were recently enunciated in Ex parte Levengood 28 U.S.P.Q. 1300 (Bd. Pat. Apps. and Int. 1993). In this decision, the Board, in reversing the Examiner's finding of obviousness, stated the following:

"In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. See, for example, *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

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In this case, however, the only suggestion for the examiner's combination of the isolated teachings of the applied references improperly stems from appellant's disclosure and not from the applied prior art. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979). At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. See *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980). See also footnote 16 of *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985). That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.

Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual "to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to what the patent applicant has done."

The law is well settled that a Patent Examiner has the burden under 35 U.S.C. §103 of presenting a *prima facie* case and can satisfy this burden only by showing that the objective teaching of the prior art would lead one skilled in the art to combine the relevant teachings of the cited references. In addition, the Examiner must show that there is either a suggestion in the references to produce the claimed invention or a compelling motivation based upon sound scientific principles. *In re Sigco Research* (CA FC) 36 U.S.P.Q.2d 1380 (1995); *In re Fine* (CA FC) 5 U.S.P.Q.2d 1596 (1988); and *Ex parte Kranz* (BdPat App&Int) 19 U.S.P.Q.2d 1216 (1990).

This well-established case law has also clearly enunciated that prior art references can only be successfully combined in an obviousness rejection when there is some teaching or suggestion in the prior art which supports the combination. However, hindsight provided by the pending application cannot be used. This principle was clearly enunciated by the Court of Appeals for the Federal Circuit in *In re Fine*, 5 U.S.P.Q. 1596, 1600 (CAFC, 1988), where the Court made the following statement:

“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’ *W.L. Gore*, F.2d at 1553, 220 USPQ at 312-13. It is essential that ‘the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.’ *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

When these clear and unequivocal principles of law are fairly applied to the present invention, it is immediately apparent that the Examiner's rejection is unsupportable and Claims 1-11 must be found to be in condition for allowance. To find otherwise would allow the Examiner to fall victim to the precise admonitions against hindsight reconstruction enunciated by the Courts.

Applicant has achieved significant success, which has been dependent on the increased degree of illumination (and improved clarity) of the display device of the present invention. This distinguishing feature has now been incorporated into the independent claims.

The Examiner has also rejected Claims 6 and 7 on the grounds that Feustle discloses the use of a honeycomb pattern. Although Feustle does not use the term “honeycomb”, his pattern is merely a series of squares and does not represent a honeycomb. However, Applicant has amended Claim 7 by including the limitation that the honeycomb form comprises interengaging hexagons. There is no teaching or

suggestion in Feustle that the honeycomb form comprise interengaging hexagons, and this is of particular benefit in obtaining the improved illumination of the display.

Based upon the foregoing Amendment and the arguments presented herein. Applicant believes that Claims 1-11 and now amended are now in condition for allowance. An early notice to this effect is earnestly solicited.

Finally, Applicant has enclosed a request for a three-month extension of time together with the requisite filing fee of \$525.00 for this three-month extension of time, extending the time through and including January 30, 2008 within which to file the foregoing Amendment.

Of course, if any questions remain which can be resolved in a telephone interview, Applicant's undersigned attorney would gladly discuss any such questions with the Examiner. For this purpose, the Applicant's Attorney has provided his telephone number below.

Sincerely yours,



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